Remarks

Claims 71, 73-76, 78-80, 83, 97-98, 100-104 and 106-117 are rejected under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent No. 5,821,523 to Bunte, et al. ("Bunte") in view of U. S. Patent No. 5,510,606 to Worthington, et al. ("Worthington"). Claims 72, 77, 81-82, 99 and 105 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bunte as modified by Worthington and further in view of U. S. Patent No. 5,979,757 to Tracy, et al. ("Tracy").

The independent claims pending in the application are as follows:

71. (Currently Amended) A system comprising:
(a) an optical reader including an imaging assembly, a display, a keyboard, an acoustic output device and a controller configured to capture image data and decode decodable bar code symbols therein, said optical reader further including a hand held housing encapsulating said imaging assembly and said controller, said hand held housing further supporting said display and said keyboard; and
(b) a host processor having an associated display spaced apart from said optical reader, wherein said hand held housing is adapted to be held in a human hand so that said optical reader is moveable between a variety of orientations and distances with respect to said host processor;
(c) wherein said system is configured so that in a first mode said host processor sends to said optical reader a beeper control instruction, wherein said optical reader substantially on receipt of said beeper control instruction actuates said acoustic output device so that said acoustic output device emits a series of beeps without actuating said display;
(d) wherein said system is further configured so that in a second mode said host processor sends to said optical reader a display control instruction, wherein said optical reader substantially on receipt of said display control instruction causes a predetermined indicia to be displayed on said display without actuating said acoustic output device.

76. (Currently Amended) A method for attracting attention of an operator of a hand held optical reader, said hand held optical reader having an artificial light source directing light toward a target, an acoustic output device, a wireless communication link, a display, and being configured to decode decodable bar code symbols represented in captured images, said method comprising the steps of:
(a) programming said hand held optical reader to wirelessly receive at least one component control instruction from a spaced apart host processor, said component control instruction being selected from the group consisting of a light source flashing component control instruction which when executed by said hand held optical reader results in said artificial light source ~~flashing according to a predetermined pattern~~ directing light toward a target of said optical reader without a frame of image data being captured, an acoustic output device component control instruction which when executed by said hand held optical reader causes said acoustic output device to emit a series of beeps without actuation of said display, and a display output component control instruction which when executed by said hand held optical reader results in a

predetermined indicia being displayed on said display without actuation of said acoustic output device, wherein said programming step includes the step of configuring said hand held optical reader to execute said at least one component control instruction to produce a user-perceivable result substantially on receipt of said component control instruction and wherein said hand held optical reader is disposed in a common local facility with a spaced apart host processor having an associated display; and

(b) wirelessly sending from [[a]] said spaced apart host processor to said hand held optical reader at least one of said light source flashing component control instruction, said acoustic output device component control instruction, and said display output component control instruction, whereby a user-perceivable result is produced by said hand held optical reader substantially on receipt of said at least one component control instruction so that attention of an operator of said hand held optical reader is attracted.

98. (Currently Amended) A system comprising:

(a) an optical reader including an imaging assembly, a display, a keyboard, a wireless communication link, a light source, an acoustic output device and a controller configured to capture image data and decode decodable bar code symbols therein, said optical reader further including a hand held housing encapsulating said imaging assembly and said controller, said hand held housing further supporting said display and said keyboard; and

(b) a host processor spaced apart from said optical reader, wherein said hand held housing is adapted to be held in a human hand so that said optical reader is moveable between a variety of orientations and distances with respect to said host processor;

(c) wherein said system is configured so that in a first mode said host processor wirelessly sends to said optical reader a beeper control instruction, wherein said optical reader substantially on receipt of said beeper control instruction actuates said acoustic output device so that said acoustic output device emits a series of beeps;

(d) wherein said system is further configured so that in a second mode said host processor sends to said optical reader a display control instruction, wherein said optical reader substantially on receipt of said display control instruction causes indicia to be displayed on said display[[-]] [[;]] and

(e) wherein said system is configured so that said host processor in a further mode sends to said optical reader a light source control instruction, said optical reader substantially on receipt of said light source instruction causes said light source to direct light toward a target of said optical reader without causing actuation of said imaging assembly.

104. (Currently Amended) A system comprising:

(a) a optical reader including an imaging assembly, a display, a keyboard, an acoustic output device and a controller configured to capture image data and decode decodable bar code symbols therein, said optical reader further including a hand held housing encapsulating said imaging assembly and said controller, said hand held housing further supporting said display and said keyboard; and

(b) a host processor having an associated display spaced apart from said optical reader and being disposed at a common local facility with said optical reader, wherein said hand held housing is adapted to be held in a human hand so that said optical reader is moveable between a variety of orientations and distances with respect to said host processor;

(c) wherein said system is configured so that in a first mode said host processor sends to said optical reader a beeper control instruction that is initiated by a user by presenting at a location spaced apart from said optical reader a command to control said optical reader, wherein said optical reader substantially on receipt of said beeper control

> instruction actuates said acoustic output device so that said acoustic output device emits a series of beeps without actuating said display;
>
> (d) wherein said system is further configured so that in a second mode said host processor sends to said optical reader a display control instruction, wherein said optical reader substantially on receipt of said display control instruction causes indicia to be displayed on said display without actuating said acoustic output device.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to once of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2D 1438 (Fed. Cir. 1991). Cited in *MPEP §2143.*

When claims are rejected for obviousness the prior art must teach each element of the claimed invention. *MPEP §2143.* Further, when a reference is complex the particular part of the reference relied upon *must* be designated as nearly as possible. *37 C.F.R. §1.104(c)(2).*

Under *MPEP §2144*, the strongest rationale for combining references is a recognition, expressly or impliedly in the prior art or drawn from a convincing line of reasoning based on established scientific principles or legal precedent, that some advantage or expected beneficial result would have been produced by their combination. *In re Sernaker*, 702 F.2d 989 (Fed. Cir. 1983). The Examiner must present a convincing line of reasoning supporting the rejections. *Ex parte Clapp*, 227 USPQ 972 (Bd. Pat. App. & Inter. 1985) also cited in *MPEP §2144.*

While the Examiner has referenced several sections of Bunte in rejecting claim 71, it is believed that the Examiner's rejection of claim 71 is insufficient for a variety of reasons. For example, it appears that the Examiner has alleged that two different elements described in Bunte satisfy the element of "a host processor" which "sends a control instruction." With the

reference to column 20, the Examiner alleges that a "person at a central location" initiating a trigger satisfies the recited claim element of a host processor which sends a control instruction which when received results in a series of beeps being emitted, and with the reference to Fig. 9 the Examiner alleges that a host part 904 of an "image capture system" sending a control instruction satisfies the recited claim element of a host processor which, when received, results in predetermined indicia being displayed on a display. According to the language of the claim as is particularly recited in claim 71, "said host processor" sends to said optical reader a beeper control instruction" and "said host processor" sends to said reader a display control instruction. In that the Examiner has referenced two different elements as satisfying the recited "host processor" claim element it is believed that the Examiner has not fully considered the claim element of the recited "said host processor" that sends both a beeper control instruction and a display control instruction. In order for the Examiner to establish a *prima facie* case of obviousness, every element of a patent claim must be established as being shown or suggested in the prior art. *MPEP §2143.*

Further, even if the Examiner had asserted that "the central location" constituted the "host processor" sending the display control instruction, the evidence provided by the Examiner still would not have been sufficient to establish that the element of "said host processor" sending a beeper control instruction and a display control instruction is shown or suggested in the Bunte. For example, while Bunte describes a "central location" as being a physical space having both non-computer elements and computer elements such as a wired network 302, a computer system 307, an access device 306 and "one or more computer devices 306" (see column 8, line 62 to column 9, line 25) there is no processor much less a particular host processor referenced in the highlighted passage at column 20 which references only a "person at a central location." The term "person at a central location" does not inherently encompass "a host processor" and if the term did inherently encompass a "host processor," the term still would not inherently encompass a particular host processor.

Further respecting the Examiner's reference to column 23 relative to the display control instruction, the Examiner's reference to the "Once the display command is

received..." passage relative to the "substantially on receipt" language of claim 71 is noted. However, it is believed that with reference to column 23, the Examiner has not made reference to a system wherein instructions are sent from a spaced apart host to an optical reader. In the applicants' view, the Examiner with the Examiner's reference to column 23 fails to make reference to a system wherein instructions are sent from a spaced apart host to an optical reader as recited in claim 71. If the Examiner's position is that Bunte contains a teaching that the display/scroll/review/delete functionality described at column 23 can be carried out with use of a "host" or "terminal" portion of an "image capture system" when in a spaced apart state relative to "an image capture module," the Examiner is respectfully requested consider more fully the teaching of Bunte at columns 12, line 28-30 that: "*When docked with the terminal unit*, the user may also interact with the module 400 via the terminal unit's interface." (*Emphasis added, Bunte column 12, lines 29-31*).

Regarding claim 76, claim 76 is amended to clarify distinctions between the invention of claim 76 and Bunte. Claim 76, as amended, requires that the spaced apart host processor which wirelessly sends a component control instruction is disposed in a common local facility with a hand held optical reader. Amended claim 76 also recites that a light source directs light toward a target area without a frame of image data being captured. It appears that the "central location" referenced by the Examiner relative to claim 76 is described as being located remotely from the element regarded as satisfying the recited hand held optical reader element of claim 76. With regard to the display element of claim 76, the argument presented relative to claim 76 that referenced column 23 does not teach a host and a reader operating in a spaced apart state are incorporated relative to claim 76. With regard to the light source and beeper elements of claim 76, it is believed that Bunte teaches away from claim 76 as amended with regard to the light source and beeper elements at least in that it appears that the Examiner references a non-local element in support of the finding that Bunte has the host processor as recited in claim 76. If the Examiner wishes to maintain the Examiner's position that Bunte has the light source and beeper elements of claim 76, the Examiner is respectfully requested to explain why modification of Bunte's "central location" would not either 1) render Bunte unsuitable for its intended purpose or 2) change the

principle of operation of the Bunte system. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification *in re Gordon,* 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). See *MPEP§ 2143.01.* Also, with regard to the light source element, Bunte teaches away from the element in that it appears that in Bunte detecting a trigger results in an image being captured.

The invention recited in claim 76 provides significant advantages and finds use in various applications, *e.g.*, where an operator of an optical reader is working in a sealed off contaminated work area of a local facility which is viewable live by an operator of local host processor within the facility. The method as recited in claim 76 can be used to attract the attention of the operator in such a work environment.[1]

Regarding claim 98, arguments presented respecting claim 71; namely, the argument regarding the Examiner's failure to consider that a common host processor sends both a beeper control instruction and display control instruction, the argument that "person at a central location" does not inherently encompass a sending by a host processor of a plurality of instruction types, and the argument that the referenced passage at column 23 does not teach a host and reader portion operating in a spaced apart state are incorporated with reference to claim 98. In addition, claim 98 has been amended to further clarify distinctions between the invention recited in claim 98 and Bunte. Claim 98, as amended, further recites a light source wherein the system is configured so that in a further mode the host processor sends to an optical reader a light source control instruction, wherein the optical reader substantially, on receipt of the light source instruction, causes the light source to direct light toward a target of said optical reader without causing actuation of the reader's imaging

[1] In this section it will be recognized that the applicants are merely referencing advantages of the recited invention and are not referencing limitations of the claims.

assembly. Applicants respectfully submit that even if all of the Examiner's positions with respect to the teachings of Bunte were correct, Bunte teaches away from claim 98. Whereas the invention of claim 98 calls for an imaging assembly to remain inactive when receiving a light source control instruction, the "trigger" referenced by the Examiner relative to claim 98 causes an image to be captured.

Regarding claim 104, arguments presented respecting claim 71; namely, the argument regarding the Examiner's failure to consider that a common host processor sends both a beeper control instruction and display control instruction, the argument that "person at a central location" does not inherently encompass a sending of a plurality of instruction types by a host processor, and the argument that the referenced passage at column 23 does not teach a host and reader portion operating in a spaced apart state are incorporated with reference to claim 104. In addition, claim 104 has been amended to clarify further distinctions between the invention recited and Bunte. In claim 104 as amended, it is recited that host processor is disposed at a common local facility with an optical reader. If the Examiner wishes to maintain the Examiner's position that claim 104 is obvious over Bunte, the Examiner is respectfully requested to explain why modification of Bunte's "central location" would not either 1) render Bunte unsuitable for its intended purpose or 2) change the principle of operation of the Bunte system. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification *in re Gordon,* 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). See *MPEP§ 2143.01.*

The invention recited in claim 104 provides significant advantages and finds use in various applications, *e.g.*, where an operator of an optical reader is working in a sealed off contaminated work area of a local facility which is viewable by an operator of local host

processor within the facility. The method as recited in claim 76 can be used to attract the attention of the operator in such a work environment.

In addition, claim 71 has been amended to reference that when an acoustic output device is actuated in response to receipt of a beeper control instruction, a display is not actuated and that when a display is actuated in response to receipt of a display control instruction, an acoustic output device is not actuated. Similar amendments also adding the term "without actuating..." are incorporated into claim 76 and claim 104. The above claim elements are supported at least by teaching in the specification of a component control instruction that can control a single component (although it is noted the reference to "without actuating..." in the claims is more broadly stated than the specification teaching of a one component control instruction). Claims 71, 76, and 104 are also amended to recite that a host processor has an associated display. It is believed that the aforementioned amendments referencing the "without actuating" and "host processor display" elements clarify distinctions between the claimed invention and the prior art including newly submitted prior art submitted by the applicants.

Regarding dependent claims 72-75, 77-83, 97, 100-103, and 105-107, dependent claims 72-75, 77-83, 97, 100-103, and 105-107 are believed to be allowable at least for the reason that they depend on an allowable base claim and for the additional combination of elements they recite. The applicants selective presentation of arguments relative to the independent claims will not be taken as an indication that the applicants regard the dependent claim rejections to have been properly made and reserve the right to present arguments in support of the patentability of one or more of the dependent claims later in prosecution or in a related application (*e.g.*, a continuation).

While the applicants herein and previously in the prosecution of the present patent application may have highlighted a particular claim element of a claim for purposes of demonstrating an insufficiency of an examination on the part of an Examiner, the applicants highlighting of a particular claim element for such purpose should not be taken to indicate

that the applicants have taken the position that a particular claim element constitutes the sole basis for patentability out of the context of the various combinations of elements of the claim or claims in which it is present.

Accordingly, in view of the above amendments and remarks, applicants believe all of the claims of the present application to be in condition for allowance and respectfully request reconsideration and passage to allowance of the application.

If the Examiner believes that contact with applicants' attorney would be advantageous toward the disposition of this case, the Examiner is herein requested to call applicants' representative at the phone number listed below.

The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to deposit Account No. 50-0289.

Respectfully submitted,
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